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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250

Complete if Known

Application Number	10/792,107
Filing Date	03/03/2004
First Named Inventor	Michelle Grandy
Examiner Name	Tan Le
Art Unit	3632
Attorney Docket No.	20119-0003

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☒ Other (please identify): USPS Money Order☐ Deposit Account Deposit Account Number: _____ Deposit Account Name: _____

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
_____ - 20 or HP = _____	x _____	= _____	

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
_____ - 3 or HP = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

Fees Paid (\$)

\$250**SUBMITTED BY**

Signature	<u>Charlena Thorpe</u>	Registration No. (Attorney/Agent)	48,035	Telephone	678-644-9922
Name (Print/Type)	Charlena Thorpe			Date	11/07/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. 20119-0003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Michelle GRANDY) Group Art Unit: 3632
Application No.: 10/792,107) Examiner: Tan Le
Filed: March 3, 2004)
For: DECORATIVE HANGING)
WASTEBASKET)

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

APPEAL BRIEF

I. Real party in interest.

The real party in interest is Michelle Grandy.

II. Related appeals and interferences.

There are no prior and/or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee that may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of claims.

Claims 1-31 are pending in the application. The Examiner asserts that Applicant's claims are directed to two distinct inventions. Specifically, the Examiner asserts that claims 1-12, 15-22, and 27-31 ("Invention I") are directed to an apparatus and that claims 13-14 and 23-26 ("Invention II") are directed to "a method of use". (See

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January 5, 2005 Office Action.) The Examiner further asserts that the application contains claims directed to patentably distinct species and identifies the following alleged species: Figs. 1-2; Figs. 3-6; Fig. 7; and Fig. 9. (*Id.*) In response to the restriction and election requirements, Applicant provisionally elected to prosecute Invention I, with traverse, and elected the species of Figs. 1-2, with traverse, on which Applicant asserted that claims 1-8, 12-16, and 19-31 read. (See Second Response to Restriction and Election Requirement dated February 6, 2006.) The Examiner concluded that claims 7-8, 10, 13, 14, 17-18, and 23-26 are drawn to a nonelected species/group and withdrew these claims from further consideration, which Applicant respectfully disputes. (See May 5, 2006 Office Action.) Accordingly, claims 1-6, 9, 11, 12, 15, 16, 19-22, and 27-31 are pending and stand rejected. Applicant appeals the rejection of claims 1-6, 9, 11, 12, 15, 16, 19-22, and 27-31.

IV. Status of amendments.

No amendments have been filed subsequent to the final rejection.

V. Summary of claimed subject matter.

Applicant provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with exemplary reference to the specification, and to the drawing, if any, by reference characters. Claims 1, 11, 12, 27, and 29 are independent claims.

Claim 1 recites an apparatus (100) for securing and concealing a storage unit (130) comprising a holder (110, 210, 220, 230) for securing a storage unit (130) to a surface; and a cover (120) attached to the holder (110), wherein the cover (120) is sized and positioned on the holder (110) to conceal in whole or in part the storage unit (130)

from being viewed in a first direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶ 15 through 6, ¶ 21.)

Claim 11 recites an apparatus comprising a storage unit (130) having a first and a second mounting piece (not shown), wherein the first mounting piece connects to a surface; and a cover (120), wherein the second mounting piece connects to the cover (120). (See, e.g., Figs. 1, Specification at p. 7, ¶ 25.)

Claim 12 recites an apparatus comprising means for securing a storage unit to a surface (110 or 210-230 or 210, 220, 230' or 710-730); and means for concealing (120, 740) in whole or in part means for securing. (See, e.g., Figs. 1-8, Specification at p. 4, ¶ 16 through page 8, ¶ 26.). The "means for securing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least any of the following groups of elements: 110 or 210-230 or 210, 220, and 230', or 710-730. The "means for concealing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least elements 120 and/or 740.

Claim 27 recites an apparatus for providing a decorative hanging wastebasket (130), comprising a holder (110, 210, 220, 230) structured to be secured to a surface and structured to hold a container (130) into which matter can be deposited or removed and a cover (120) connected to the holder (110, 210, 220, 230) that is structured and positioned on the holder to conceal a container (130) held by the holder (110, 210, 220, 230) from being viewed in at least one direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶ 15 through 6, ¶ 21.)

Claim 29 recites an apparatus for providing a decorative hanging wastebasket (130), comprising a holder (110, 210, 220, 230) that includes a first section (210) structured to attach to a wall, a second section (220) structured to support a wastebasket above a floor adjacent to the wall, and a third section (230) structured to connect to a concealing cover; and a cover (120) connected to the third section (230) of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket (130) supported by the holder (110, 210, 220, 230) and wherein the cover (120) is connected to the third section (230) of the holder in an orientation that hides the at least one surface of the wastebasket (130) from being seen from at least one direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶ 15 through 6, ¶ 21.)

VI. Grounds of rejection to be reviewed on appeal.

Applicant presents the following grounds of rejection for review.

A. Ground 1:

The Examiner rejected claim 3 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because “in no way did the written description specifically describe or the drawings show exactly how ‘any combination of the plate, the ring piece, and the first mounting piece are detachable’.” (See May 5, 2006 Office Action at p. 6.)

B. Ground 2:

The Examiner has rejected claims 2-6, 9, 16, and 31 under 35 U.S.C. § 112, second paragraph, as being indefinite because of the recitation of “the surface” and “the storage unit” in claims 2 and 9 and “a wastebasket” in claim 31. Although the Examiner

list claims 3-6 and 16 as being rejected, the Examiner provides no explanation for these rejections.

C. Ground 3:

The Examiner has rejected claims 1, 2, 4-6, and 9, 11, 12, 15, 16, 19-22 and 27-31 under 35 U.S.C. § 102(b) as being anticipated by Barbour.

D. Ground 4:

Claim 3, a dependent claim, recites that “any combination of the plate, the ring piece, and the first mounting piece are detachable.” The Examiner has objected to the drawings under 37 CFR 1.83(a) because they do not show this feature. However, when Applicant attempted to amend the drawing to show this feature, the Examiner objected to amendment to the drawings because the Examiner claims that the specification is not enabled for this feature.

VII. Argument.

A. Ground 1:

The Examiner rejected claim 3 under 35 U.S.C. § 112, first paragraph, on the ground that “in no way did the written description specifically describe or the drawings show exactly how ‘any combination of the plate, the ring piece, and the first mounting piece are detachable’.”

First, MPEP 2163 provides:

There is a **strong presumption** that an adequate written description of the claimed invention is present in the specification as filed. **Consequently, rejection of an original claim for lack of written description should be rare.**

(internal citation omitted)(emphasis added).

Second, 35 U.S.C. § 112, first paragraph, does not require that the specification “specifically describe” or “show exactly” details that are well known in the art. Accordingly, 35 U.S.C. § 112, first paragraph, does not require Applicant to “specifically describe” or “show exactly how” any combination of the plate, the ring piece, and the first mounting piece are detachable. Instead, 35 U.S.C. § 112, first paragraph, requires only that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, **in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same**, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(emphasis added). Regarding this requirement, MPEP 2164.01 provides, “**A patent need not teach, and preferably omits, what is well known in the art.**” (emphasis added)(citing In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)).

Furthermore, MPEP 2164.08 provides:

The Federal Circuit has repeatedly held that “the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation’.” In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). **Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted.** In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). **All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art.**

(emphasis added).

Attachment and detachment of mechanical parts, such as the elements in question, is well known in the art and one of ordinary skill in the art would be able to detach the elements in question without “the written description specifically describe[ing] or the drawings show[ing] exactly how” to detach the elements. See e.g., U.S. Patent No. 6,594,834 (“The various parts of the invention can be manufactured with pre-drilled holes for easy assembly and disassembly using any conventional fastening means including nut/bolt assemblies, screw and lager assemblies, and pins of various kinds.”). Furthermore, Applicant is not required to describe the multitude of possible ways that the elements could be detached, since it would be clear to one of ordinary skill in the art. See e.g. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F. 2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Based on the above, Applicant is not required to “specifically describe” or “show exactly” how any combination of the plate, the ring piece, and the first mounting piece are detachable as the Examiner erroneously asserts.

Third, MPEP 2163 provides:

The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims,”

(emphasis added). In view of the teachings of 35 U.S.C. § 112, first paragraph, MPEP 2164.01, and MPEP 2164.08 as discussed above, the Examiner has presented no evidence or reasons why a person of ordinary skill in the art would not be able to practice the invention as recited in claim 3 given the level of knowledge and skill in the art. MPEP 2164.05 states, “**The examiner should never make [an enablement]**

determination based on personal opinion.” See also In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art and, if the Applicant traverses such an assertion, the Examiner should cite a reference in support of his or her position.); MPEP 2164.05 (“The examiner should never make [an enablement] determination based on personal opinion.”).

B. Ground 2:

It is clear that claims 2 and 9 recite “storage unit” and “surface” functionally. Claim 2, which depends on claim 1, recites, “a plate that attaches to *the surface*” and “a ring piece attached to the plate that receives *the storage unit* and holds *the storage unit* in place”, referring back to the surface and storage unit recited in claim 1. Similarly, claim 9 recites, “a plate that attaches to *the surface*” and “a platform on which *the storage unit* sits, wherein the platform is attached to the plate.” In claims 2 and 9, with respect to the surface and storage unit, the plate and ring piece are defined in terms of attributes they possess and in terms of their functional interrelationship with the surface

and storage unit when the plate and ring piece are used in its intended manner, rather than positively reciting the surface and storage unit. See, e.g., Ex parte Miller, No. 97-0972 (Bd. Pat. App. & Inter. 1998) (unpublished). In Ex parte Miller, the Examiner rejected a claim under 35 U.S.C. § 112, second paragraph, because the preamble recited “a theater seat hold-down device for maintaining a seat member” but the body of the claim recited “an elongated member . . . configured to engage at least one said seat member.” The Examiner argued that “seat member” was functionally recited in the preamble but positively recited in the body and therefore presented an inconsistency thereby justifying a rejection under 35 U.S.C. § 112, second paragraph. The Board reversed the Examiner’s rejection, holding:

We do not agree with the examiner’s position. The examiner apparently recognizes that the appellants, by setting forth functional recitations such as that of the hold-down device being “adapted” to engage the theater seat, have not positively recited the theater seat as a part of the claimed combination. Nevertheless, the examiner has taken the position that limitations such as that of the of hold-down device being “configured” (i.e, shaped) to engage a portion of a theater seat (previously set forth in the preamble), positively claim the theater seat as part of the claimed combination. **We must point out, however, that by reciting such language the appellants have merely defined the hold-down member in terms of attributes it must possess and, therefore, this language is also functional in character. That is, the appellants are merely defining the shape or structural configuration of the hold-down device in terms of its functional interrelationship with the theater seat when it is used in its intended manner, rather than positively reciting the theater seat as a part of the claimed combination.** Since we are not of the opinion that the theater seat has been positively set forth as a part of the claimed combination, we find no inconsistency between the preamble and the body of the claim as the examiner asserts. This being the case, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph.

(emphasis added). The Examiner provides no support for why the claims are indefinite based on what the Examiner has pointed to as the alleged problem. The claims as currently written satisfy the requirements of 35 U.S.C. § 112, second paragraph.

C. Ground 3:

1. **Introduction**

Applicant respectfully submits that Barbour does not disclose each and every element recited in 1, 2, 4-6, and 9, 11, 12, 15, 16, 19-22 and 27-31 and, therefore, does not anticipate these claims. MPEP 2131. Furthermore, the various functional limitations in the claims set forth a function that the apparatus must be structurally capable of performing and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims. See, e.g., In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); MPEP 2173.05(g).

2. **Barbour is nonanalogous art and cannot be consider**

Barbour does not anticipate the claims because it does not disclose each and every element of the claims and, therefore, is not a § 102 reference. Accordingly, Barbour is at most a potential § 103 reference. However, MPEP 2141.01(a) provides that to rely on a reference under § 103, it must be analogous prior art. Barbour is not analogous prior art and, therefore, cannot be used as a basis for rejecting the claims.

MPEP 2141.01 provides:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

(citing In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)).

Accordingly, for the Examiner to rely on Barbour as a basis for rejecting the claims,

Barbour must either (1) be in the field of Applicant's endeavor or (2) if not in the field of Applicant's endeavor, be reasonably pertinent to the particular problem with which Applicant was concerned. Barbour is neither in the field of Applicant's endeavor nor reasonably pertinent to the particular problem with which Applicant was concerned, as discussed below.

a) Barbour is not in the field of Applicant's endeavor

The Federal Circuit has narrowly construed the field of an inventor's endeavor. For example, in In re Clay, the Federal Circuit reversed the PTO's rejection of the applicant's invention over two reference holding:

The PTO argues that Sydansk and Clay's inventions are part of a common endeavor -- "maximizing withdrawal of petroleum stored in petroleum reservoirs." **However, Sydansk cannot be considered to be within Clay's field of endeavor merely because both relate to the petroleum industry.** Sydansk teaches the use of a gel in unconfined and irregular volumes within generally underground natural oil-bearing formations to channel flow in a desired direction; Clay teaches the introduction of gel to the confined dead volume of a man-made storage tank. The Sydansk process operates in extreme conditions, with petroleum formation temperatures as high as 115 degrees C and at significant well bore pressures; Clay's process apparently operates at ambient temperature and atmospheric pressure. **Clay's field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of Sydansk's invention, on the other hand, is the extraction of crude petroleum.** The Board clearly erred in considering Sydansk to be within the same field of endeavor as Clay's.

966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) (emphasis added). MPEP 2141.01(a) characterizes the Federal Circuit's opinion in In re Clay as follow:

The court disagreed with the PTO's argument that the reference and claimed inventions were part of the same endeavor, "maximizing withdrawal of petroleum stored in petroleum reserves," and found that the inventions involved different fields of endeavor since the reference taught the

use of the gel in a different structure for a different purpose under different temperature and pressure conditions, and since the application related to storage of liquid hydrocarbons rather than extraction of crude petroleum.

As can be seen above, the Federal Circuit construed the inventor's field of endeavor narrowly. While the patent application and reference both related to the petroleum industry, the Federal Circuit characterized them as being in entirely separate fields. In re Oetiker is another example of the Federal Circuit's narrow construction of the field of an inventor's endeavor. 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Regarding In re Oetiker, MPEP 2141.01(a) notes:

Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. **The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.**

Regarding the field of Applicant's endeavor in the present application, Applicant was concerned with the problem posed by having a wastebasket located on a floor, for example in a toddler's room, because, for example, it may allow undesired access to the wastebasket by a child to retrieve items from the wastebasket or to dispose of items not intended for a wastebasket. Additionally, Applicant was concerned with the aesthetics of a wastebasket. Accordingly, Applicant's invention is related to an apparatus for securing a wastebasket to a surface having a decorative cover to conceal

the wastebasket. Thus, as set forth in the Field of Invention, Applicant's invention relates to a decorative hanging wastebasket, which is the field of Applicant's endeavor.

Barbour concerns a holder for a glass, tooth brushes, and a tube of toothpaste that can be secured against a wall or other support. Barbour discloses that the objects of the invention include: (1) providing improved means for opening and closing the tube of toothpaste and constructing the means for opening and closing the tube of toothpaste to prevent it from being bent out of shape; (2) providing means for supporting a tooth brush so that paste can be evenly distributed along the brush as it is slid under the tube of toothpaste, and (3) providing a device so that "a glass may be very easily set in place or removed from a ring which supports tooth brushes not in use and prevents a glass from becoming wedged into place."

Barbour in no way concerns securing a wastebasket to a surface and providing a decorative cover to conceal the wastebasket. As discussed above, Barbour concerns a holder for a glass, tooth brushes, and a tube of toothpaste, means for opening and closing the tube of tooth paste and means for applying the tooth paste. Although, Barbour discloses securing a holder to a surface, Barbour and the present invention are in entirely separate fields of endeavor. See, e.g., In re Ray, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) (holding, "Sydansk cannot be considered to be within Clay's field of endeavor merely because both relate to the petroleum industry.").

For the above reasons, Barbour cannot be considered to be in the same field of endeavor as Applicant's invention.

- b) **Barbour is not reasonably pertinent to the particular problem with which the inventor was concerned**

As with the field of an inventor's endeavor, the Federal Circuit has narrowly construed the problem the inventor sought to overcome. For example in In re Clay, the Federal Circuit held:

Sydansk's gel treatment of underground formations functions to fill anomalies [FN1] so as to improve flow profiles and sweep efficiencies of injection and production fluids through a formation, while Clay's gel functions to displace liquid product from the dead volume of a storage tank. Sydansk is concerned with plugging formation anomalies so that fluid is subsequently diverted by the gel into the formation matrix, thereby forcing bypassed oil contained in the matrix toward a production well. Sydansk is faced with the problem of recovering oil from rock, i.e., from a matrix which is porous, permeable sedimentary rock of a subterranean formation where water has channeled through formation anomalies and bypassed oil present in the matrix. Such a problem is not reasonably pertinent to the particular problem with which Clay was involved -- preventing loss of stored product to tank dead volume while preventing contamination of such product. Moreover, the subterranean formation of Sydansk is not structurally similar to, does not operate under the same temperature and pressure as, and does not function like Clay's storage tanks. See In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) ("the similarities and differences in structure and function of the invention disclosed in the references . . . carry far greater weight [in determining analogy]").

A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies. The Board's finding to the contrary is clearly erroneous.

966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). In re Oetiker is another example of the Federal Circuit's narrow construction of the problem the inventor sought to overcome. 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Regarding In re Oetiker, MPEP 2141.01(a) notes:

Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly

“hook” which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. **The court held the reference was not within the field of applicant’s endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.**

(emphasis added). The Federal Circuit stated the test for determining whether a reference is reasonable pertinent to the particular problem with which the inventor was concerned as follows:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is **one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.** Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve.

In Re Clay, 966 F.2d at 659, 23 USPQ2d at 1060-61 (Fed. Cir. 1992). See also MPEP 2141.01(a).

Regarding the “reasonable” requirement, the Federal Circuit has held:

[I]t is necessary to consider ‘the reality of the circumstances’ – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.”

In re Oetiker, 977 F.2d at 1447 (Fed. Cir. 1992) (emphasis in original).

The particular problem with which the present invention was involved concerned concealing a wastebasket that has been secured to a surface.

The purpose of Barbour is to provide a bathroom accessory for holding a glass, tooth brushes, and a tube of toothpaste that can be secured against a wall or other support. Barbour discloses that the objects of the invention include: (1) providing improved means for opening and closing the tube of toothpaste and constructing the means for opening and closing the tube of toothpaste to prevent it from being bent out of shape; (2) providing means for supporting a tooth brush so that paste can be evenly distributed along the brush as it is slid under the tube of toothpaste, and (3) providing a device that "a glass may be very easily set in place or removed from a ring which supports tooth brushes not in use and prevents a glass from becoming wedged into place."

Barbour is not reasonably pertinent because it logically would not have commended itself to an inventor's attention in considering the problem of concealing a wastebasket that has been secured to a surface. A person of ordinary skill would not reasonably be expected to look to the field of holders for a glass, tooth brushes, and a tube of toothpaste for a solution to concealing a wastebasket that has been secured to a surface.

Since the Examiner bears the initial burden of factually supporting any prima facie conclusion that a reference is analogous prior art, Applicant respectfully requests that the Examiner do so if the Examiner continues to apply Barbour to reject the claims. See e.g. In Re Ray, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992); MPEP 2141; MPEP 2141.01(a).

3. The Examiner's construction of "Cover" is not reasonable

For each of the rejected claims, the Examiner identifies the tube of tooth paste 17 disclosed in Barbour as the cover recited in the claim.

MPEP 2111 provides:

During patent examination, the pending claims must be given broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

...

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe restore hair growth to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

See also MPEP 2111.01; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983)

("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original).

The tube of tooth paste 17 is not a cover because to interpret cover to include a tube of tooth paste is not reasonable, not consistent with the specification, and not consistent with the interpretation one of ordinary skill in the art would reach. Accordingly, Barbour does not disclose a cover as recited in the claims.

4. Claims 1

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 1 recites "a cover attached to the holder, wherein the cover is sized and

positioned on the holder to conceal in whole or in part the storage unit from being viewed in a first direction.” Barbour does not disclose or teach that the tooth paste tube 17 conceals in whole or in part a storage unit. The Examiner does not particular point out the “storage unit” that the tooth paste tube 17 allegedly conceals, but, it is assumed that the “storage unit” is the glass 3. The Examiner contends that “the [tooth paste tube 17] is inherently sized to conceal in part a storage unit.” (See May 5, 2006 Office Action, p. 8). MPEP 2112 provides:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . . In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

It does not “necessarily flow from the teachings” of Barbour that the tooth paste tube 17 conceals a storage unit. Barbour discloses and teaches that the tooth paste tube 17 is not intended to conceal the glass 3 and in fact teaches that the tooth paste tube 17 is designed to actually *reveals* the glass with each use of the tube because, as shown in Figure 1 and disclosed in the specification, tooth paste tube key 17' is turned to expel the tooth paste by winding-up the tube. See Figure 1, element 17' and column 3 lines 65-71 (“The brush may be moved longitudinally while resting upon the support 29 and during this movement the key 17' of the tube will be turned to expel paste from the neck 18 thereof, and the paste will be distributed along the entire length of the brush.”).

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

5. Claims 19

Applicant incorporates by reference the arguments in sections VII(C)(1)-(4). Claim 19 recites that “the cover is sized and positioned on the holder to conceal **in whole** the storage unit from being viewed in a first direction.” As clearly shown in Figs. 1 and 3 of Barbour, the tooth paste tube 17 does not conceal **in whole** the glass 3 as the sides of the glass and the bottom of the glass are clearly visible in any direction. Accordingly, Barbour does not disclose that “the cover is **sized and positioned** on the holder to conceal **in whole** the storage unit from being viewed in a first direction” as recited in claim 19.

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

6. Claim 20

Applicant incorporates by reference the arguments in sections VII(C)(1)-(5). Claim 20, which depend from claims 19, recites that the first direction is directed toward a front elevation. As clearly shown in Fig. 3 of Barbour, which is a front elevation, the tooth paste tube 17 does not conceal **in whole** the glass 3 as the sides of the glass 3 and the bottom of the glass 3 are clearly visible. Accordingly, Barbour does not disclose that the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a direction directed toward a front elevation.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

7. Claim 21

Applicant incorporates by reference the arguments in sections VII(C)(1)-(5). Claim 21, depends from claim 19 and claim 1 and recites that “the cover is sized and positioned on the holder to conceal **in whole** the storage unit **and holder** from being viewed in a first direction.” Barbour does not teach or suggest that the alleged cover (i.e., the tooth paste tube 17) conceals in whole a storage unit **and** conceals in whole a holder, which the Examiner identifies as elements 1, 5, 13, and 23. As clearly shown by Figs. 1-3 of Barbour, the tooth paste tube 17 does not conceal **in whole** the glass 3 **and does not conceal in whole** elements 1, 5, 13, and 23. Accordingly, Barbour does not disclose that “the cover is **sized and positioned** on the holder to conceal **in whole** the storage unit **and holder** from being viewed in a first direction” as recited by claim 21.

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

8. Claim 22

Applicant incorporates by reference the arguments in sections VII(C)(1)-(5) and (7). Claim 22, which depends from claim 21, recites that the first direction is directed toward a front elevation. As clearly shown in Fig. 3 of Barbour, which is a front elevation, the tooth paste tube 17 does not conceal **in whole** the glass 3 **and**, as shown in Figs. 1 and 3, **does not conceal in whole** elements 1, 5, 13, and 23. Accordingly, Barbour does not disclose that the cover is sized and positioned on the holder to conceal in whole the storage unit and holder from being viewed in a direction directed toward a front elevation.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

9. **Claim 27**

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 27 recites, "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction." "Conceal" without qualification means "to keep from being seen, found, observed, or discovered; hide". See The American Heritage Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000. This definition is consistent with the specification. The Examiner does not particular point out the "container" that the tooth paste tube 17 allegedly conceals, but, it is assumed that the "container" is the glass 3. The tooth paste tube 17 does not keep from being seen, found, observed, or discovered or otherwise hide the glass 3 when viewed in at least one direction. Instead, Barbour discloses and teaches that the tooth paste tube 17 actually *reveals* the glass with each use of the tube because, as shown in Figure 1 and disclosed in the specification, tooth paste tube key 17' is turned to expel the tooth paste by winding-up the tube. See Figure 1, element 17' and column 3 lines 65-71 ("The brush may be moved longitudinally while resting upon the support 29 and during this movement the key 17' of the tube will be turned to expel paste from the neck 18 thereof, and the paste will be distributed along the entire length of the brush."). Accordingly, Barbour does not "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction."

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

10. Claim 28

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3) and (9). Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. As clearly shown in Fig. 3 of Barbour, which is a front elevation, the tooth paste tube 17 does not conceal the glass 3 as the sides of the glass 3 and the bottom of the glass 3 are clearly visible. Accordingly, Barbour does not teach or suggest a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in a direction directed toward a front elevation.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

11. Claim 29

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 29 recites, “a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction.” Barbour does not teach or suggest that the alleged cover (i.e., tooth paste tube 17) includes “at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder.” Neither does Barbour teach or suggest that “the cover is connected to the third section of the

holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction” or a front elevation.

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

12. Claim 30

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3) and (11). Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. As clearly shown in Fig. 3 of Barbour, which is a front elevation, the tooth paste tube 17 does not hide at least one surface of the glass 3 as the sides of the glass 3 and the bottom of the glass 3 are clearly visible. Accordingly, Barbour teach or suggest a cover that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from a front elevation.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

13. Claim 4

Applicant incorporates by reference the arguments in sections VII(C)(1)-(4). Claim 4 recites that “wherein the cover comprises a second mounting piece connected to the first mounting piece.” The Examiner identifies element 17 (tooth paste tube) as the cover and elements 18-22 and 27-29 as the second mounting piece. For Barbour to anticipate this claim, the tooth paste tube 17 must comprise elements 18-22 and 27-29.

This clearly is not the case. Element 31, which is a part of element 27, is the only part that touches tooth paste tube 17. (See, e.g., Barbour, Fig. 2 and col. 3, lines 39-54.) However, this does not make elements 18-22 and 27-29 part of the tooth paste tube 17 such that Barbour discloses “wherein the cover comprises a second mounting piece.”

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

14. **Claim 16**

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3) and (13). Claim 16 recites, “a second mounting piece **attached to** the cover and first mounting piece.” Barbour does not disclose that elements 18-22 and 27-29, and in particular element 31, which is the only part that touches tooth paste tube 17, attach to tooth paste tube 17. Instead, Barbour discloses that element 31 is seated in the lower end of the neck of the tooth paste tube 17, when not in use. (See, Barbour, Fig. 2 and col. 3, lines 45-47.)

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

15. **Claim 5**

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 5 recites “wherein the second mounting piece is detachable from the first mounting piece.” The Examiner identifies elements 13 and 23 as the first mounting piece and elements 18-22 and 27-29 as the second mounting piece. Barbour does not disclose that elements 13 and 23 are detachable from elements 18-22 and 27-29. In fact, Barbour discloses that these elements are designed to “prevent

disengagement.” See Barbour, col. 3 line 10. Applicant requested that the Examiner particularly point out where this element is disclosed in Barbour so that Applicant may have the opportunity to reply to the rejection completely. See 37 CFR 1.104 (“When a reference is complex . . . the particular part relied on must be designated as nearly as practicable.”); MPEP 706 (“The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.”). The Examiner continues to summarily assert that Barbour discloses this element without citing to anything in Barbour for support.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

16. **Claims 9**

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 9 recites “a platform on which the storage unit sits, wherein the platform is attached to the plate”. The Examiner identifies element 1 as the platform and element 5 as the plate, however, a storage unit does not sit on element 1. Barbour discloses that “[a]rms or strips 8 . . . are bent inwardly to form feet 9 projecting toward each other and adapted to engage under a glass and support the same.” See Barbour, col. 1 lines 55-60. Thus, Barbour discloses that a glass sits on element 9 and not element 1. However, element 9 is not attached to element 5 as would be required by the claim. Accordingly, Barbour does not disclose “a platform on which the storage unit sits, wherein the platform is attached to the plate.”

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

17. Claim 11

Claim 11 recites “a storage unit **having** a first and a second mounting piece, wherein the first mounting piece connects to a surface and a cover, wherein the second mounting piece connects to the cover.” The Examiner does not particular point out the “storage unit” in Barbour, but, it is assumed that the “storage unit” is the glass 3. Barbour does not disclose or teach that the glass 3 has a first and second mounting piece wherein the first mounting piece connects to a surface. The Examiner identifies the first mounting piece as element 5, however, element 5 is not a part of glass 3. The Examiner identifies the second mounting piece as elements 18-22 and 27-29. However, these elements are not a part of the glass 3 either.

Additionally, for the reasons set forth in section VII(C)(3), Barbour does not disclose a cover. Finally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

18. Claim 12

Claim 12 recites “means for concealing in whole or in part means for securing” The Examiner identifies the “means for securing” as element 5 and the “means for concealing” as tooth paste tube 17. However, tooth paste tube 17 does not conceal element 5 as shown in Fig. 1. Tooth paste tube 17 is at a different elevation than element 5; therefore, it's impossible for tooth past tube 17 to conceal element 5. Tooth paste tube also does not any of the other parts of the holder. Accordingly, Barbour does not disclose “means for concealing in whole or in part means for securing.” Furthermore, Barbour does not disclose the structure disclosed in the specification corresponding to the recited function.

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

19. **Claim 3**

Applicant incorporates by reference the arguments in sections VII(C)(1)-(3). Claim 3 recites “wherein any combination of the plate, the ring piece, and the first mounting piece are detachable.” The Examiners identifies the plate as element 5, the ring piece as element 1, and the first mounting piece as elements 13 and 23. However, Barbour does not disclose or teach that any combination of these elements is detachable. Accordingly, Barbour does not disclose that “wherein any combination of the plate, the ring piece, and the first mounting piece are detachable.”

Additionally, for the reasons set forth in section VII(C)(2), Barbour is not a proper reference because it is not a § 102 reference and is nonanalogous art.

D. Ground IV

37 CFR 1.83(a) provides:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. **However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).**

(emphasis added). The detachability of any combination of the plate, the ring piece, and the first mounting is a conventional feature and a detailed illustration is not essential for a proper understanding of the invention to one of ordinary skill in the art. Accordingly, Applicant attempted to amend Fig. 2 to include dashed lines to provide an exemplary illustration of the detachability of the plate, the ring piece, and the first

mounting piece. (See July 5, 2005 Amendment). If the Examiner contends that a more detailed illustration is needed for a proper understanding of the invention to one of ordinary skill in the art, the Examiner must provide support for this contention. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner should cite a reference in support of his or her position.).

During and interview, the Examiner expressed the opinion that Applicant could not amend the drawings to illustrate the detachability of the plate, the ring piece, and the first mounting piece without adding new matter. The Examiner stated that the drawings must show exactly the location of the detachment of the parts and any amendment to the drawing to show such detachment would add new matter. Applicant respectfully disagrees with the Examiner. As discussed in greater detail below, it is not necessary to show exactly the location of the detachment of the parts; only an exemplary

illustration of the detachability of the plate, the ring piece, and the first mounting piece is required and to amend the drawing for such an exemplary illustration does not add new matter since it was already disclosed in the specification and the claims.

MPEP 2163.07 provides, "Amendments to an application which are supported in the original description are NOT new matter." (Emphasis in original.) Additionally, MPEP 2163.06 provides:

[I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter

...

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.

The addition of the dashed lines to Fig. 2 to show an exemplary illustration of the detachability of the plate, the ring piece, and the first mounting piece is supported in the original specification, the original drawings, and the original claims. Specifically, the original specification provides:

[019] In one embodiment, as shown in Fig. 2, the basket holder 110 may include a plate 210, a ring piece 220, and a first mounting piece 230. The plate 210, ring piece 220, and first mounting piece 230 may be detachable from the basket holder 110. For example, the first mounting piece 230 may be detachable from the ring piece 230. This may be useful to replace one mounting piece with a different mounting piece based, for example, on the second mounting piece 240 of the decorative cover 120, discussed below. Alternatively, the basket holder 110 may be one integral piece (i.e., undetachable).

[020] The plate 210 may have one or more small holes 250 for screws or other mounting objects to fit in order for the

basket holder 110 to be attached to a wall or other surface. Alternatively, the plate 210 may be attached to the wall or other surface using an adhesive material, for example. The ring piece 220 may be in a shape that allows a wastebasket 130 to fit evenly and securely into it. Spacers may also be used to help securely fit a wastebasket 130 in the ring piece 220. The first mounting piece 230 may be made of any material, such as plastic, metal, velcro, aluminum, steel, any combination of the foregoing, or any other type of material including any rigid material. The first mounting piece 230 can be used to connect with, fit in, or attach to the second mounting piece 240 of the decorative cover 120. The first mounting piece 230 may also securely connect the decorative cover 120 to the basket holder 110.

The above structural and functional description of the plate, the ring piece, and the first mounting piece in conjunction with the original Fig. 2, for example, which includes lead lines pointing to the plate, the ring piece, and the first mounting piece, and the original claims, which recite detachability of the parts, provide support to amend Fig. 2, without adding new matter, to illustrate an exemplary embodiment of the detachability of the plate, the ring piece, and the first mounting piece.¹

Regarding the specific location of the dashed lines, which the Examiner has raised as a requirement during the interview, the Federal Circuit has held:

As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent

¹ In Pandrol USA, LP v. Airboss Railway Products, Inc., 320 F.3d 1354; 65 U.S.P.Q.2D (BNA) 1985 (2003), the Federal Circuit held that the addition of a layer 12 to a drawing was "without significance" in response to Examiner's initial objection to the drawings under 37 C.F.R. §1.83(a). The specification originally recited that "[t]he plate 10 may be bonded by adhesive (epoxy resin adhesives are preferred) to the tie 1" The Examiner objected to the drawings because they did not include an illustration of the "adhering material." The applicant amended the drawing to add a layer 12 to illustrate the adhering material. In addition to amending the drawing, the applicant amended the specification to read that "[t]he plate 10 may be bonded by layer 12 of adhesive (epoxy resin adhesives are preferred) to the tie 1"

See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F. 2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Accordingly, Applicant is not required to include in the specification all possible locations of the detachability of the parts of the exemplary embodiments of the present invention, since one of ordinary skill in the art could easily obtain these locations. Therefore, the addition of the dashed lined in an exemplary location is not new matter. If the Examiner contends that one of ordinary skill in the art could not easily obtain the locations of the detachability of the parts, then the Examiner must provide support for this contention. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well-known” in the art and, if the Applicant traverses such an assertion, the Examiner should cite a reference in support of his or her position.).

VIII. Claims appendix.

Appendix A contains a copy of the claims involved in the appeal.


IX. Evidence appendix.

No evidence appendix is provided as there was no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

X. Related proceedings appendix.

No related proceedings appendix is provided as there are no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii).

Respectfully submitted,



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APPENDIX A

1. An apparatus for securing and concealing a storage unit, comprising:
a holder for securing a storage unit to a surface; and
a cover attached to the holder, wherein the cover is sized and positioned on the holder to conceal in whole or in part the storage unit from being viewed in a first direction.

2. The apparatus of claim 1, wherein the holder comprises:
a plate that attaches to the surface;
a ring piece attached to the plate that receives the storage unit and holds the storage unit in place; and
a first mounting piece attached to the ring piece.

3. The apparatus of claim 2, wherein any combination of the plate, the ring piece, and the first mounting piece are detachable.

4. The apparatus of claim 2, wherein the cover comprises a second mounting piece connected to the first mounting piece.

5. The apparatus of claim 4, wherein the second mounting piece is detachable from the first mounting piece.

9. (Original) The apparatus of claim 1, wherein the holder comprises:
a plate that attaches to the surface; and
a platform on which the storage unit sits, wherein the platform is attached to the plate.

11. An apparatus comprising:
a storage unit having a first and a second mounting piece, wherein the first mounting piece connects to a surface; and

a cover, wherein the second mounting piece connects to the cover.

12. An apparatus comprising:

means for securing a storage unit to a surface; and

means for concealing in whole or in part means for securing.

16. The apparatus of claim 2, further comprising a second mounting piece structured to attach to the cover and the first mounting piece.

19. The apparatus of claim 1, wherein the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a first direction.

20. The apparatus of claim 19, wherein the first direction is directed toward a front elevation.

21. The apparatus of claim 19, wherein the cover is sized and positioned on the holder to conceal in whole the storage unit and holder from being viewed in a first direction.

22. The apparatus of claim 21, wherein the first direction is directed toward a front elevation.

27. An apparatus for providing a decorative hanging wastebasket, comprising:
a holder structured to be secured to a surface and structured to hold a container into which matter can be deposited or removed; and

a cover connected to the holder that is structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.

28. The apparatus of claim 27, wherein the at least one direction is directed toward a front elevation.

29. An apparatus for providing a decorative hanging wastebasket, comprising:

a holder that includes a first section structured to attach to a wall, a second section structured to support a wastebasket above a floor adjacent to the wall, and a third section structured to connect to a concealing cover; and

a cover connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction.

30. The apparatus of claim 29, wherein the at least one direction is directed toward a front elevation.